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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NICOLA GIULIANI

Appeal 2014-002653
Application 11/916,066
Technology Center 3700

Before EDWARD A. BROWN, WILLIAM A. CAPP, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Nicola Giuliani (Appellant)¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–5, 7–26, 28, and 30–32.² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION.

¹ IM-BALL-CENTER S.r.L. is identified as the real party in interest. Appeal Br. 1.

² Claims 6, 27, and 29 have been cancelled. Appeal Br. 44, 48.

CLAIMED SUBJECT MATTER

Claims 1, 22, and 30 are independent. Claim 1, reproduced below, illustrates the claimed subject matter.

1. A thermal bag, comprising:
thermally insulating composite material folded to form a bottom and welded along lateral borders to form a body of the bag with a mouth at the level of which a handle is applied, said handle having a hand grip portion and a longitudinal portion forming at least a portion of a closing device for said mouth, said composite material defining a bottom folded in an accordion-like fashion opposite the mouth of the bag, wherein a laminar stiffening element of the accordion-like bottom is disposed inside the bag, said hand grip portion and said longitudinal portion having a shorter length than a length of said mouth when the bag is in a flattened position, wherein in the folded position an accordion forming the bottom of the bag has beveled borders along which welding lines are produced, the beveled borders on each side of the bag converging in a corner, the two opposed corners being joined by a folding line of the accordion-like bottom.

REJECTIONS

The Examiner rejects the claims under 35 U.S.C. § 103(a) as unpatentable over the noted combinations of references:

Claims 1–3, 5, 7, 13–16, 20, 21, and 30–32 over Martineau (US 2003/0035596 A1, published Feb. 20, 2003), Moravek (US 5,158,371, issued Oct. 27, 1992), and Wilkins (GB 2,225,567 A, published June 6, 1990);

Claims 4 and 8 over Martineau, Moravek, Wilkins, and Campbell (US 4,211,091, issued July 8, 1980);

Claim 9 over Martineau, Moravek, Wilkins, and Cornish (US 3,678,703, issued July 25, 1972);

Claims 10 and 11 over Martineau, Moravek, Wilkins, and Takahashi (US 5,912,058, issued June 15, 1999);

Claim 12 over Martineau, Moravek, Wilkins, and Bomes (US 5,105,919, issued Apr. 21, 1992);

Claim 17 over Martineau, Moravek, Wilkins, and Ossian (US 4,190,477, issued Feb. 26, 1980);

Claims 22–24, 26, and 28 over Moravek, Martineau, Wilkins, and Van Erden (US 4,759,642, issued July 26, 1988); and

Claim 25 over Moravek, Martineau, Wilkins, Van Erden, and Campbell.

ANALYSIS

*Claims 1–3, 5, 7, 13–16, 20, 21, and 30–32
over Martineau, Moravek, and Wilkins*

Claims 1–3, 5, 7, 13–16, 20, and 21

Claim 1 recites the limitation “in the folded position an accordion forming the bottom of the bag has *beveled borders along which welding lines are produced*, the beveled borders on each side of the bag converging in a corner, the two opposed corners being joined by a folding line of the accordion-like bottom.” Appeal Br. 43 (Claims App.) (emphasis added) (hereafter “folded position limitation”). Appellant references Figure 3 as showing the “folded position” of the bag. Appeal Br. 2. Regarding Figure 3, the Specification describes that

[t]he folding lines 9 and 11 define two edges 12 of composite material which form the accordion defining the bottom of the bag. In the *folded position (Figure 3)* it can be seen that *the edges*

12 are beveled and the bag has a lower portion defined, besides by the folding lines 11, by pairs of welding lines 13 inclined by approximately 45° with respect to the welded borders 3.

Spec. 3:32–4:3 (emphasis added), Fig. 3. Figure 3 shows welding lines 13 along beveled edges 12 in the folded position.

The Examiner finds that Martineau does not teach that the sides of the thermal bag are welded, or the bottom of the bag has beveled borders formed by welding lines and which converge in corners joined by the accordion-like bottom. Final Act. 2–3 (citing Martineau ¶ 22, Figs. 1, 2). The Examiner finds that Moravek teaches a bag having sides joined by welding the lateral borders (along heat seal lines 20, 21), and a bottom having corners at which the edges of the bag are joined by heat seals 20, 21 to form beveled gussets. *Id.* at 3 (citing Moravek, col. 2, ll. 34–38 and 48–53, Figs. 1, 5A).

Appellant contends that Moravek does not teach or suggest the folded position limitation. Appeal Br. 11. In this regard, Appellant contends that neither gusset 13 nor heat seals 20, 21 form beveled borders, as claimed. *Id.* at 12.

The Examiner responds that Moravek Figure 1 shows the bag having a bottom including triangular end portions 39, 40, which are beveled with respect to the bottom of the bag which they form part of the border. Ans. 23. As to the recited “welding lines,” the Examiner determines that Figure 1 shows heat seal lines 20, 21, which along both edges converge to the uppermost corner of the triangular end piece. *Id.*

Appellant replies that Moravek Figure 3 does not show “beveled borders,” as claimed, as end portions 39 and 40 only form triangular gussets. Reply Br. 2. Appellant also contends that heat seal lines 20, 21 are not produced along end portions 39, 40. *Id.* at 3.

We are persuaded by Appellant that the Examiner does not establish any disclosure in Moravek of the bag, when in a “folded position,” as claimed, having “beveled borders along which welding lines are produced,” where “the beveled borders on each side of the bag converg[e] in a corner.” Moravek Figure 1 shows bag 10 in the “open position,” not a “closed position,” and Figure 3 shows bag 10 in the “collapsed position.” *See* Moravek, col. 2, ll. 13–14, 17–20. Appellant’s Figures 1 and 2, for example, show bag 1 in an “open position.” *See* Spec. 3:7–8, 12. The “open position” and “collapsed position” of bag 10 shown in Figures 1 and 3 of Moravek appear similar to the bag’s “open position” and “folded position” in Appellant’s Figures 1 and 3, respectively. But even assuming the “collapsed position” of bag 10 in Moravek corresponds to the claimed “closed position,” the Examiner does not establish that the bottom of bag 10 has “beveled borders” in this position. Further, Moravek Figure 3 shows heat seal lines 20, 21 extending vertically and parallel to each other along the opposite edges of bag 10. The Examiner does not identify where any “beveled borders” along which heat seal lines 20, 21 are produced are shown in Figure 3, or otherwise disclosed in Moravek. For these reasons, the Examiner’s finding that Moravek discloses the folded position limitation of claim 1 is not supported by a preponderance of the evidence.

Thus, because the Examiner’s rejection relies on unsupported findings regarding the teachings of Moravek, we do not sustain the rejection of claim 1, and claims 2, 3, 5, 7, 13–16, 20, and 21 depending therefrom, as unpatentable over Martineau, Moravek, and Wilkins.

Claims 30–32

The Examiner rejects claim 30 based on the same findings and reasoning as provided for claim 1. Final Act. 19–20.

Appellant points out correctly, however, that claim 30 recites different limitations from claim 1. Appeal Br. 37. Claim 30 recites, *inter alia*, the limitations: 1) the handle has an integral portion having an integral portion length that is less than a length of the bag mouth portion with the bag body in a flattened position, 2) the bag bottom portion has a length that is less than the bag mouth portion length, and 3) the bag bottom portion length is less than the integral portion length. *Id.* Appellant contends that Martineau, Moravek, and Wilkins fail to teach or suggest each of these limitations. *Id.* at 38.

The Examiner responds that support web 1 shown in Wilkins Figure 1 corresponds to the claimed “integral portion.” Ans. 36. The Examiner also states that “the recitations and discussion provided with regard to claim 1 were and are considered sufficient to demonstrate the obviousness of the subject matter of claim 30.” *Id.* at 37.

We are persuaded that the Examiner fails to establish that the applied combination of references supports the rejection of claim 30. The Examiner’s response appears to address only limitation “1” above with any specificity. Ans. 36–37. Even assuming the Examiner’s position is correct regarding this limitation, the Examiner still does not provide adequate findings and reasoning to support the position that the applied combination of references also meets limitations “2” and “3,” which are not recited in claim 1. However, “[t]he Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA

1967). Absent this factual basis, the Examiner also does not provide adequate reasoning with a rational underpinning to support the conclusion of obviousness for claim 30. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Thus, we do not sustain the rejection of claim 30, and claims 31 and 32 depending therefrom, as unpatentable over Martineau, Moravek, and Wilkins.

Claims 4 and 8 over Martineau, Moravek, Wilkins, and Campbell
Claim 9 over Martineau, Moravek, Wilkins, and Cornish
Claims 10 and 11 over Martineau, Moravek, Wilkins, and Takahashi
Claim 12 over Martineau, Moravek, Wilkins, and Bomes
Claim 17 over Martineau, Moravek, Wilkins, and Ossian

Claims 4, 8–12, and 17 depend, directly or indirectly, from claim 1. The Examiner's reliance on Campbell to reject claims 4 and 8 (Final Act. 9–11), Cornish to reject claim 9 (*id.* at 11), Takahashi to reject claims 10 and 11 (*id.* at 11–12), Bomes to reject claim 12 (*id.* at 12), and Ossian to reject claim 17 (*id.* at 13) does not cure the deficiencies of the rejection of claim 1 discussed above. Accordingly, we do not sustain the rejections of claims 4, 8–12, and 17 over the noted combinations of references.

New Ground of Rejection of Claims 22–26 and 28

Claim 22 recites the limitation “welding lines are produced along said continuous composite material, inclined with respect to the direction of feed, extending from *an intermediate position of the transverse extension of the composite web material* towards the longitudinal folding lines.” Appeal Br. 47 (Claims App.) (emphasis added) (hereafter “welding line limitation”). We determine that the meaning of “the transverse extension of the composite web material” is unclear.

The Patent and Trademark Office “determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (citing *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). Regarding the claims, the welding line limitation in claim 22 appears in original claim 24. *See* Spec. 11:19–23. However, claim 24, and claims 25 and 26 depending therefrom, do not provide any indication as to the meaning of this language.

Accordingly, we next look to the Specification for guidance as to the meaning of “the transverse extension of the composite web material.” Appellant references page 3, line 34 to page 4, line 3, and page 7, lines 3–5, of the Specification, and Figures 1, 2, and 8B, for support with regard to the welding line limitation. Appeal Br. 2. Appellant specifically notes welding lines 13, composite web material M_c, and longitudinal folding lines 9, 11. *Id.* We note these reference numbers are shown in the figures. However, we also note that the referenced disclosure does not mention the “transverse extension” of the composite web material. Consequently, we are unable to determine the meaning of this term, and thus, of “an intermediate position of the transverse extension of the composite web material,” from the referenced disclosure. Further, we are unable to find the term “transverse extension” elsewhere in the original disclosure. We thus are unable to determine the meaning of this term in view of the Specification.

Thus, because the meaning of language in claim 22 is unclear, we enter a new ground of rejection of claim 22, and claims 23–26 and 28

depending therefrom, under 35 U.S.C. § 112, second paragraph, as indefinite, pursuant to our authority under 37 C.F.R. § 41.50(b).

*Claims 22–24, 26, and 28 over Moravek, Martineau, Wilkins,
and Van Erden*

Claim 25 over Moravek, Martineau, Wilkins, Van Erden, and Campbell

As we have determined that claims 22–24, 26, and 28 are indefinite, we cannot sustain the rejections of claims 22–24, 26, and 28 under 35 U.S.C. § 103(a) as unpatentable over Moravek, Martineau, Wilkins, and Van Erden, and of claim 25 under 35 U.S.C. § 103(a) as unpatentable over Moravek, Martineau, Wilkins, Van Erden, and Campbell, because to do so would require speculation as to the scope of the claims. *See In re Aoyama*, 656 F.3d 1293, 1300 (Fed. Cir. 2011) (holding that the Board erred in affirming an anticipation rejection of indefinite claims); *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Board erred in affirming a rejection of indefinite claims under 35 U.S.C. § 103(a), because the rejection was based on speculative assumptions as to the meaning of the claims).³

DECISION

The Examiner’s decision to reject claims 1–5, 7–26, 28, and 30–32 is reversed.

We enter a new ground of rejection of claims 22–26 and 28 under 35 U.S.C. § 112, second paragraph, as indefinite.

³ Our decision is based solely on the indefiniteness of the claimed subject matter, and does not reflect any decision on the adequacy of the combinations of references applied by the Examiner in the rejections of claims 22–26 and 28.

FINALITY OF DECISION

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under §41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the *Manual of Patent Examining Procedure* § 1214.01 (9th Ed., Rev. 07.2015, Nov. 2015).

No time period for taking any subsequent action in connection with this appeal may be extended according to 37 C.F.R. § 1.136(a)(1)(iv).

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Application 11/916,066

REVERSED; 37 C.F.R. § 41.50(b)